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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,420	03/31/2004	Erik D.N. Monsen	F-803	5680

919 7590 12/09/2010

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EXAMINER

SALLIARD, SHANNON S

ART UNIT	PAPER NUMBER
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3628

NOTIFICATION DATE	DELIVERY MODE
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12/09/2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIK D.N. MONSEN,
RONALD P. SANSONE, and
IAN A SIVEYER

Appeal 2010-004103
Application 10/814,420
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Erik D.N. Monsen, et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-3 and 5-24. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.²

THE INVENTION

The invention relates to “the field of mailing and, more particularly, to the field of inducting manifest mail into a mail stream.” Specification [0002].

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method for providing proof of mailing one or more mail pieces by a mailer, that are submitted by a mailer to a post office in a bundle or in a tray, the method comprises the steps of:

(a) placing an identification code on individual mail pieces with a postage meter at a location other than the post office, wherein the identification code identifies a sender of the mail piece a service requested for the mail piece and uniquely identifies individual mail pieces;

(b) placing the identification codes of the mail pieces in a manifest;

(c) transmitting the identification codes to a data center;

² Our decision will make reference to the Appellants’ Appeal Brief (“Br.,” filed Feb. 3, 2009) and the Examiner’s Answer (“Answer,” mailed May 18, 2009).

(d) depositing one or more mail pieces and the manifest with the post office at the post office or at a location other than the post office;

(e) attempting reading by the post office at a location other than the post office or at the post office the identification codes in the manifest;

(f) attempting reading by the post office at a location other than the post office or at the post office the identification code that is on one more mail pieces;

(g) retrieving the identification codes from the data center and the identification codes read by the post office;

(h) notifying the postage meter that individual identification codes have been received by the data center and individual mail pieces identification codes have been read or not read by the post office; and

(i) printing at the postage meter a certificate indicating the identification code that has been read by the post office and the service requested for the mail piece.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Lee	US 6,430,543 B1	Aug. 6, 2002
Dlugos, Sr.	US 5,153,842	Oct. 6, 1992
Pintsov	US 6,463,354 B1	Oct. 8, 2002
Gawler	US 2002/0010687 A1	Jan. 24, 2002
Ryan, Jr.	US 2002/0026430 A1	Feb. 28, 2002
Montgomery	US 2003/0101147 A1	May 29, 2003

With respect to claim 9, the Examiner states: “the Examiner takes Official Notice that it is old and well known in the postage art at the time of the invention that the id code contains the time that the

postage mark was affixed to a mail piece.” Answer 11. [Official Notice I]

With respect to claim 9, the Examiner states: “it is old and well known in the art at the time of the invention that United States Special Service Tracking Number are used as identification on mail pieces.” Answer 11, [Official Notice II]

The following rejections are before us for review:

1. Claims 1-3, 5, 6, 8, 10, 12-15, and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lee, Ryan, Jr., Gawler, and Pintsov.
2. Claims 7, 11, 16-19, and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lee, Ryan, Jr., Gawler, Pintsov, and Montgomery.
3. Claims 9 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lee, Ryan, Jr., Gawler, Pintsov, and Official Notice I and II.
4. Claims 22 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lee, Ryan, Jr., Gawler, Pintsov, and Dlugos, Sr.

ISSUE

The issue is whether the Examiner erred in rejecting claims 1-3 and 5-24 under §103(a) over the cited prior art.

FINDINGS OF FACT

We rely on the Examiner’s factual findings stated in the Answer. Additional findings of fact may appear in the Analysis below.

ANALYSIS

The rejection of claims 1-3, 5, 6, 8, 10, 12-15, and 24 under 35 U.S.C. §103(a) as being unpatentable over Lee, Ryan, Jr., Gawler, and Pintsov.

The Appellants argued claims 1-3, 5, 6, 8, 10, 12-15, and 24 as a group (Br. 8). We select claim 1 as the representative claim for this group, and the remaining claims 2, 3, 5, 6, 8, 10, 12-15, and 24 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Brief reproduces passages from the cited prior art that the Examiner cited in support of the rejection. Br. 8-14. Then the Brief concludes by saying that “[t]he art cited by the examiner do not disclose or anticipate steps [(a)] and [(i)] of claim [1]”. Br. 14.

The Brief does not persuade us of error in the rejection.

The question here is one of obviousness, not anticipation. In that regard, “[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007).” As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co.*, 550 U.S. at 418.

Furthermore, the test for obviousness is what the *combined* teachings of the references would have suggested to one of ordinary skill in the art. *See In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991) and *In re Keller*, 642 F.2d 413, 425, (CCPA 1981). Here the Appellants have focused on each of the cited references without considering what the *combined* teachings of the

references would have suggested to one of ordinary skill in the art. This is important because the Examiner relied on a combination of references to reject claim 1. For example, with respect to step (a), the Examiner's position was that the step is obvious over the combination of Lee and Ryan, Jr. The Examiner relied on Lee as disclosing the "placing an identification code on individual mail pieces with a postage meter at a location other than the post office, wherein the identification code identifies a sender of the mail piece [] and uniquely identifies individual mail pieces" portion of step (a). Answer 3. The Examiner conceded that Lee does not disclose the limitation "[placing an identification code on individual mail pieces with a postage meter at a location other than the post office, wherein the identification code] identifies a service requested for the mail piece" of step (a). Answer 4. Instead, the Examiner relied on Ryan, Jr. Answer 4. The Examiner found that

[i]t would have been obvious to one of ordinary skill in the art to include in the postage system of Lee et al the ability to print an identification code that identifies a service requested for the mail pieces as taught by Ryan, Jr. since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Answer 4-5.

Accordingly, the Appellants' argument that the references do not disclose or anticipate the claimed subject matter does not persuade us of error in the rejection.

We will affirm the Examiner's decision to reject claim 1, and claims 2, 3, 5, 6, 8, 10, 12-15, and 24 which stand or fall with claim 1, under §103 over the combination of Lee, Ryan, Jr., Gawler, and Pintsov.

The rejection of claims 7, 11, 16-19, and 21 under 35 U.S.C. §103(a) as being unpatentable over Lee, Ryan, Jr., Gawler, Pintsov, and Montgomery.

The Appellants argued claims 7, 11, 17-19, and 21 separately. (Br. 15-17).

The Appellants' argument challenging the rejection of claim 7 suffers for the same reasons discussed above with respect to the rejection of claim 1. The Brief reproduces a passage from Montgomery and then concludes that the prior art does "not disclose or anticipate" the subject matter of claim 7. Br. 16. However, it is clear from reading the Answer that the rejection of claim 7 is over a combination of references, not Montgomery alone. See especially Answer 14-15 where the Examiner elaborates on the obviousness of the claimed subject matter over the combined references.

Accordingly, the Appellants' argument that the references do not disclose or anticipate the claimed subject matter does not persuade us of error in the rejection of claim 7.

We reach the same conclusion with respect to the arguments challenging the rejection of claims 11, 16-19, and 21. For each claim, the Appellants argue that the references do not disclose or anticipate the claimed subject matter. For the reasons already stated we do not find these arguments persuasive as to error in the rejection.

The rejection of claims 9 and 20 under 35 U.S.C. §103(a) as being unpatentable over Lee, Ryan, Jr., Gawler, Pintsov, and Official Notice I and II.

The Appellants argued claims 9 and 20 as a group (Br. 17). We select claim 9 as the representative claim for this group, and the remaining claim 20 stands or falls with claim 9. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants rely on the arguments challenging the rejection of claim 1 to challenge the rejection of claim 9. Br. 17. Accordingly, for the reasons already discussed, the Appellants' arguments do not persuade us of error in the rejection of claim 9, and claim 20 which stands or falls with claim 9.

The rejection of claims 22 and 23 under 35 U.S.C. §103(a) as being unpatentable over Lee, Ryan, Jr., Gawler, Pintsov, and Dlugos, Sr..

The Appellants argued claims 22 and 23 as a group (Br. 17). We select claim 22 as the representative claim for this group, and the remaining claim 23 stands or falls with claim 22. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants rely on the arguments challenging the rejection of claim 1 to challenge the rejection of claim 22. Br. 17. Accordingly, for the reasons already discussed, the Appellants' arguments do not persuade us of error in the rejection of claim 22, and claim 23 which stands or falls with claim 22.

DECISION

The decision of the Examiner to reject claims 1-3 and 5-24 is affirmed.

AFFIRMED

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